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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,099	12/20/2001	Deborah L. Barclay	LUC-311/Barclay 4-3-2	9731

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EXAMINER

ADDY, ANTHONY S

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 07/29/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,099

Applicant(s)

BARCLAY ET AL.

Examiner

Anthony S Addy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-6, 9-16 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Kenyon, U.S. Patent Number 6,766,174**.

Regarding claim 1, Kenyon discloses a method comprising the steps of sending, to a called party at a first location, a call from a calling party having a second location (see col. 3, lines 10-19 and Fig. 1; where a system diagram which provides an overview for the communications system is shown); providing at least one of the first location to the calling party and the second location to the called party (see col. 3, line 64 through col. 4, line 5).

Regarding claim 2, Kenyon discloses all the limitations of claim 1. In addition, Kenyon teaches a step of providing the called party with at least two options for granularity of the location (see col. 4, lines 34-40, col. 4, line 15-21 and Fig. 4; where different geographical location information are shown).

Regarding claim 3, Kenyon discloses all the limitations of claim 1. In addition, Kenyon teaches a method wherein the location is displayed using non-geodetic nomenclature (see col. 5, lines 18-34).

Regarding claim 4, Kenyon discloses all the limitations of claim 1. In addition, Kenyon teaches a step of processing the location to automatically provide information based on the location to the called party (see col. 3, line 64 through col. 4, line 3).

Regarding claim 5, Kenyon discloses all the limitations of claim 4. In addition, Kenyon teaches a method wherein the information based on the location is at least one of a map illustrating the location and directions from the location to the called party (see col. 4, lines 3-12)

Regarding claim 6, Kenyon discloses all the limitations of claim 1. In addition, Kenyon teaches a step of at least one of the called party and the calling party querying for a location of the other party (see col. 5, lines, 39-51 and Fig. 5; where a flowchart describes in detail the operation of the switch for providing the directional information after a subscriber calls).

Regarding claim 9, Kenyon teaches all the limitations of claim 1, In addition, Kenyon teaches a step of providing the called party with at least two options for formatting display of the location (see col. 5, lines 52-61).

Regarding claim 10, Kenyon teaches all the limitations of claim 1. In addition, Kenyon teaches a computer-readable signal-bearing medium comprising computer readable program code that performs the steps of claim 1 (see col. 1 line 65 through col. 2, line 25).

Regarding claim 11, Kenyon discloses a method comprising the steps of providing a user with a selection of at least two location display options (see col. 4, lines 34-40, col. 4, line 15-21 and Fig. 4; where different geographical location information are shown); based on the user's selection of location display options, determining location information for a calling party that places a call to the user (see col. 5, lines 9-34); providing the location information to the user for display by the user (see col. 5, lines 31-34).

Regarding claim 12, Kenyon discloses all the limitations of claim 11. In addition, Kenyon teaches wherein at least two location display options provide at least two options for granularity of the location (see col. 4, lines 34-40, col. 4, line 15-21 and Fig. 4; where different geographical location information are shown).

Regarding claim 13, Kenyon discloses all the limitations of claim 11. In addition, Kenyon teaches a method wherein the location is displayed using common nomenclature (see col. 5, lines 18-34).

Regarding claim 14, Kenyon discloses all the limitations of claim 11. In addition, Kenyon teaches a step of processing the location to automatically provide information based on the location to the called party (see col. 3, line 64 through col. 4, line 3).

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Regarding claim 15, Kenyon teaches all the limitations of claim 11. In addition, Kenyon teaches a computer-readable signal-bearing medium comprising computer readable program code that performs the steps of claim 11 (see col. 1 line 65 through col. 2, line 25).

Regarding claim 16, Kenyon discloses all the limitations of claim 11. In addition, Kenyon teaches a step of at least one of the called party and the calling party querying for a location of the other party (see col. 5, lines, 39-51 and Fig. 5; where a flowchart describes in detail the operation of the switch for providing the directional information after a subscriber calls).

Regarding claim 19, Kenyon teaches all the limitations of claim 11, In addition, Kenyon teaches a step of providing the called party with at least two options for formatting display of the location (see col. 5, lines 52-61).

Regarding claim 20, Kenyon teaches all the limitations of claim 19. In addition, Kenyon teaches a method wherein at least two options for formatting include at least two of text, building map, street map, and city map (see col. 4, lines 15-21).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kenyon, U.S. Patent Number 6,766,174** as applied to claim 1 above, and further in view of **Granstam et al., U.S. Patent Number 6,587,691, (hereafter Granstam)**.

Regarding claims 7 and 8, Kenyon teaches a method comprising the steps of sending, to a called party at a first location, a call from a calling party having a second location (see col. 3, lines 10-19 and Fig. 1; where a system diagram which provides an overview for the communications system is shown); providing at least one of the first location to the calling party and the second location to the called party (see col. 3, line 64 through col. 4, line 5). Kenyon does not teach a step of sending a party's location information only when the party has given permission and further comprising the step of, when the calling party has a least one of restricted location information and failed to permit sending location, inhibiting sending of location information to the called party.

Granstam, however, discloses a step to protect the integrity of the user of the mobile station, so as to prevent the location of the mobile station being established by an outsider against the will of the user. In this respect, an authorization check is carried out in conjunction with a request for determination of the geographical location of a mobile station. The geographical location is only determined when authorization is found for the mobile station to be located. The authorization control involves checking that the user of the mobile station has granted permission for the location of his mobile station to be determined on the part of an outsider (see col. 2, lines 18-38).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Kenyon to include the location

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information restriction feature, for the benefit of providing a flexible integrity protection service which enables the geographical location of the mobile station to be determined when the user so desires or when it is in the user's interest for the location of the mobile station to be determined.

5. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kenyon, U.S. Patent Number 6,766,174** as applied to claim 11 above, and further in view of **Granstam et al., U.S. Patent Number 6,587,691, (hereafter Granstam)**.

Regarding claims 17 and 18, Kenyon teaches a method comprising the steps of sending, to a called party at a first location, a call from a calling party having a second location (see col. 3, lines 10-19 and Fig. 1; where a system diagram which provides an overview for the communications system is shown); providing at least one of the first location to the calling party and the second location to the called party (see col. 3, line 64 through col. 4, line 5). Kenyon does not teach a step of sending a party's location information only when the party has given permission and further comprising the step of, when the calling party has a least one of restricted location information and failed to permit sending location, inhibiting sending of location information to the called party.

Granstam, however, discloses a step to protect the integrity of the user of the mobile station, so as to prevent the location of the mobile station being established by an outsider against the will of the user. In this respect, an authorization check is carried out in conjunction with a request for determination of the geographical location of a mobile station. The geographical location is only determined when authorization is found for the mobile station to be located. The authorization control involves checking

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that the user of the mobile station has granted permission for the location of his mobile station to be determined on the part of an outsider (see col. 2, lines 18-38).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Kenyon to include the location information restriction feature, for the benefit of providing a flexible integrity protection service which enables the geographical location of the mobile station to be determined when the user so desires or when it is in the user's interest for the location of the mobile station to be determined.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wortham, U.S. Patent Number 6,748,226 discloses a system and method for locating a mobile unit within the service area of a mobile communications network.

Belcea, U.S. Patent Number 6,728,545 discloses a system and method for computing the location of a mobile terminal in a wireless communications network.

Johansson et al., U.S. Patent Number 6,442,391 discloses a location security for a subscriber unit in telecommunication system by denying parties location request.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S Addy whose telephone number is 703-305-8487. The examiner can normally be reached on Mon-Fri 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 703-308-4825. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony S. Addy
July 23, 2004



ERIKA GARY
PATENT EXAMINER